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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/248,524	02/09/1999	AMIT R. SHAH	2870/72	8887

7590 04/09/2002
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EXAMINER

BERMAN, ALYSIA

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 04/09/2002

20

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/248,524	SHAH, AMIT R.	
	Examiner	Art Unit	
	Alysia Berman	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Receipt is acknowledged of the amendment and associate power of attorney filed January 24, 2002. Claims 3, 8, 12 and 20 have been amended. Claims 1-22 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 15-18 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not provide a written description of a flow-through cosmetic applicator.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

5. Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. The term "long-wearing" in claims 1, 10, 19 and 22 is a relative term that renders the claims indefinite. The term "long-wearing" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one

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of ordinary skill in the art would not be reasonably apprised of the scope of the invention. This rejection is maintained for reasons of record.

7. Claims 1-4, 6-13 and 15-21 are indefinite because the independent claims recite the term, "derived". This rejection is maintained for reasons of record in the Office Action dated September 25, 2001, paper no. 17.

8. Claims 15-18 are indefinite because it is unclear what Applicant intends by a flow-through cosmetic applicator. Neither the specification nor the claims provides a definition or description of a flow-through applicator. The metes and bounds of the claims cannot be determined.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-14 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,874,072 (072).

US '072 discloses a mascara comprising an ammonium acrylate polymer (col. 2, line 61 to col. 3, line 1 and the examples) and organic pigments (col. 5, line 63 to col. 6, line 32). The amount of polymer in the compositions is from about 3-60 wt.% (col. 2, lines 30-34). The compositions of the examples contain from 10-34% polymer. The amount of pigment is from about 3-30% (col. 6, lines 4-7). US '072 teaches throughout the section on pigments spanning columns 5 and 6 that various mixtures of pigments

can be used. Thus, US '072 teaches the use of inorganic pigments in combination with organic pigments in the compositions.

For the process of mixing the polymer with the pigments, see the processing directions at column 7. US '072 discloses that the mascara compositions of the reference exhibit improved wear compared to known compositions, which fail to produce long term effects (long wearing). See column 1, lines 18-33. The expression "comprising" in the claims is inclusive of all the additional ingredients in major amounts. See *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App.1948).

US '072 does not explicitly teach water-soluble organic pigments. US '072 discloses D&C Yellow No. 5 (CI 19,140) as an organic pigment that is suitable for the mascara compositions (col. 6, lines 26-27). This CI number of this pigment given by US '072 is the same CI number of FD&C Yellow No. 5. See the attaches STN REGISTRY file of FD&C Yellow No. 5. US '072 discloses the use of the water-soluble organic pigment FD&C Yellow No. 5 as in instant claim 8.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use a water-soluble organic pigment such as FD&C Yellow No. 5 in the composition of US '072 for its coloring properties with the reasonable expectation of obtaining a long lasting mascara composition.

11. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,874,072 (072) in combination with US 4,761,277 (277).

US '072 teaches all the limitations of the claims as stated in the 35 U.S.C. 103(a) rejection above. It does not teach a flow-through applicator with a nib.

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US '277 teaches at column 1, lines 12-14 that flow-through nib pen applicators are known for application of liquid eyeliner cosmetics. US '277 discloses water-soluble organic pigments such as FD&C Yellow No. 5 and FD&C Blue No. 1 at column 1, lines 58-62. US '277 teaches equivalency between D&C and FD&C pigments. US '277 teaches that water-soluble ingredients are desired to avoid clogging the applicators during use.

It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition which is to be used for the very same purpose. *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). The idea of combining them flows logically from their having been individually taught in the prior art. *In re Crockett*, 279 F.2d 274, 276-77, 126 USPQ 186, 188 (CCPA 1960). US '072 and US '227 are both drawn to the same field of endeavor, cosmetics, and are solving the same problem, long lasting cosmetic effects.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the composition of US '072 in a flow-through nib pen applicator and substitute one of the water-soluble organic pigments as taught by US '277 in order to provide cosmetic compositions that can be easily applied to the eye area.

Unexpected Results

12. It is applicant's burden to demonstrate unexpected results over the closest prior art. See MPEP 716.02, also 716.02 (a) - (g). Furthermore, the unexpected results should be demonstrated with evidence that the differences in results are in fact

unexpected and unobvious and of both statistical and practical significance. *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992). Moreover, evidence as to any unexpected benefits must be "clear and convincing" *In re Lohr*, 137 USPQ 548 (CCPA 1963), and be of a scope reasonably commensurate with the scope of the subject matter claimed, *In re Linder*, 173 USPQ 356 (CCPA 1972).

In the instant case, no data was seen.

Response to Arguments

13. Applicant's arguments filed January 24, 2002 with respect to the prior art rejections of claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

14. Applicant's arguments filed January 24, 2002 with respect to the 35 U.S.C. 112, 2nd paragraph rejections have been fully considered but they are not persuasive.

15. Applicant argues that the term "long-wearing" is described in the specification as being retained on the skin for up to a full day without smudging or running. Neither the claims nor the specification are limited to this definition. Further, this description states up to a fully day and, therefore, encompasses any shorter length of time. One skilled in the art cannot determine a clear and concise definition of the term "long-wearing" based on the disclosure of the instant specification.

16. Applicant argues that one of ordinary skill in the art would understand the scope of the acrylic acid derived polymer and copolymer in light of the specification. A fair review of the specification did not reveal an exclusive definition of the derived polymers. The specification at page 3, 2nd paragraph, describes the polymeric component of the

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polymer but does not give any guidance as to any additional substituents on or derivation of the polymers. One skilled in the art cannot determine the metes and bounds of the derivation of the polymers based on the disclosure of the specification.

17. Applicant's arguments filed August 9, 2001 with respect to the prior art rejections of the claims over US '072 and US '277 have been fully considered but they are not persuasive.

18. Applicant argues that US '072 does not teach water-soluble pigments. As stated previously and in the 35 U.S.C. 103(a) rejection above, US '072 disclose D&C Yellow No. 5 at column 6, lines 27-28, which is one of Applicants' preferred water-soluble pigments of instant claim 8. Although the examples of US '072 are directed to pigments incorporated into the oil phase, this does not limit the reference to non water-soluble pigments as argued. US '072 discloses various types of pigments which include water-soluble organic pigments as stated above. All disclosures in a reference patent must be evaluated, including non-preferred embodiments. A reference is not limited to disclosure of the specific working examples. See *In re Mills* 176 USPQ 196 (CCPA 1972).

Disclosure of a composition of matter in a reference may be anticipatory even though the reference indicates that the composition is not preferred or even that it is unsatisfactory for the intended purpose. See *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). One of ordinary skill in the art would understand how to use the disclosed water-soluble pigments depending on the desired properties of the final product.

19. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by

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combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, the motivation to combine US '072 and US '277 is to provide colored cosmetic compositions that can be easily applied to the eye area. US '072 teaches the use of various inorganic, organic, water-soluble and non water-soluble pigments for use alone or in combination in cosmetic compositions for use around the eye area. US '277 discloses that eyeliner compositions are conventionally provided in flow-through nib pen applicators. US '277 also teaches that water-soluble components are desirable for use in compositions that are provided in these types of applicators in order to avoid clogging the applicator. One of ordinary skill in the art would understand from the above references that water-soluble organic pigment are desirably used in cosmetic compositions that are to be housed in and applied with a flow-through nib pen applicator in order to avoid the prior art problems of clogging.

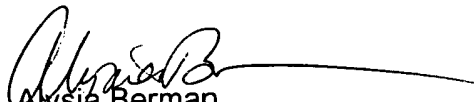
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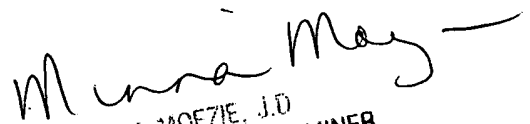
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703-308-4638. The examiner can normally be reached Monday through Friday between 9:00 am and 5:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie, can be reached on 703-308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 or 703-872-9307 for after-final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234 or 703-308-1235.


Alysia Berman
Patent Examiner
April 4, 2002


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